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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/171,735 12/04/98 SCHONBECK J 3245-628PCT

IM22/0329
COHEN PONTANI LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK NY 10176

EXAMINER

COY, N

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/29/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Applicati n N . 09/171,735	Applicant(s) SCHONBECK ET AL.	
	Examiner Nicole Coy	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on Jan. 19, 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definitions of metallurgical and geometrical characteristics are unclear. Applicant provides no guidance in the application as to if these pertain to grain structure or phase changes. Therefore, the limitations of these terms are indefinite.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 6-13 are rejected under 35 U.S.C. as being unpatentable over Maebara et al.

Maebara et al. discloses the invention substantially as claimed. Maebara et al. discloses a direct rolling method for continuously cast slabs and apparatus thereof. Maebara et al. discloses:

- (1) A direct rolling method for a continuously cast slab of steel comprising:
carrying out preliminary rolling of a continuously cast steel slab
hot rolling the slab after preliminary rolling
- (2) A method as set forth in (1) mentioned above further comprising coiling the slab after preliminary rolling using a coiler and uncoiling the slab prior to the hot rolling (Col. 3, lines 50, 65).

Furthermore, Fig 3 is a schematic plan view of a production line employing a direct rolling apparatus according to the present invention (Col. 4, lines 63-65). In Fig. 3, Maebara et al. discloses a final coiling step, which would produce a plurality of finished coils from the finished strip.

Maebara et al. further discloses a direct rolling apparatus with a variable speed motor (Col. 4, lines 16-17).

Maebara et al. further discloses that if desired a mandrel may be inserted into the coil during coiling (Col. 13, lines 55-57).

However, Maebara et al. does not disclose the changing of the metallurgical characteristics and the geometrical characteristics.

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Changes in temperature, concentrations, or other process conditions of an old process does not impart patentability unless the recited ranges are critical, i.e., they produce a new and unexpected result. In re Aller et al. (CCPA 1955) 220 F2d 454, 105 USPQ 233.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maebara et al. by including the changes in metallurgical and geometrical characteristics in order to produce a homogenous structure.

Conclusion

5. The prior art made of record and not relied upon is considered general background information.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is (703)308-3860. The examiner can normally be reached on Monday-Friday 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Prince Willis, Jr. can be reached on (703)308-3050. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3599 for regular communications and (703)305-7719 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0651.

Nicole Cary

nac
March 20, 2000

DJ Jenkins
Daniel J. Jenkins
Primary Examiner